Claims 6, 10-11, 17, 20, 22, 27-29, 31-35, and 37 are pending in the subject application.

Claims 6, 10-11, 17, 20, 22, 27-28, 32, 34-35 and 37 have been amended. Claims 1-5, 7-9, 12-

16, 18-19, 21, 23-26, 30 and 36 have been canceled. No new matter is raised by these claims

amendments.

It appears that the Examiner did not address claims 27-37 added in the Amendment filed

on October 13, 2003. In the office action dated November 19, 2003, the Examiner erroneously

noted that "Claims 6-11, 17-22 and 26 are pending in the application," and failed to indicate that

claims 27-37 were also pending. Further, the Examiner did not address these claims in the office

action as he neither stated that they were allowed nor did he reject them. Accordingly,

Applicants respectfully request that the finality of the present office action be removed so the

Examiner can fully examine these claims and allow the applicants an opportunity to respond to

such examination.

Rejection of claims 6-11, 17-22 and 26 under of 35 U.S.C. §112, First Paragraph - Written Description

Claims 6-11, 17-22 and 26 stand rejected under 35 U.S.C. § 112, first paragraph, on the

grounds that the claimed invention is not described in such a way that one of ordinary skill in the

art would be convinced that the Applicant was in possession of the claimed genus at the time of

filing.

The claims have been amended or canceled, thus rendering this ground of rejection moot.

Accordingly, applicants request withdrawal of this ground of rejection.

Rejection under 35 U.S.C. § 103(a)

9

Claims 6-11, 17-22 and 26 have been rejected under 35 U.S.C. over Gonzalez et al. (U.S.

Patent 6,015,673) in view of Willhauck et al. (Biotechniques (1998) 25:656-659).

Applic. No. 09/842,111 Amdt. dated Feb. 17, 2004

Reply to Office Action of Nov. 19, 2003

Applicants respectfully disagree as Gonzalez does not teach each and every element of the claimed invention and Willhauck and Buck do not make up for these deficiencies. For instance, the present claims involve fixing a portion of a tumor sample in paraffin. Gonzalez does not teach or suggest this. The present claims involve isolating mRNA from the fixed and paraffin embedded (FPE) tumor tissue. Gonzalez does not teach or suggest this. The present claims involve amplifying mRNA from the FPE tumor tissue. Gonzalez does not teach or suggest this. The present claims also involve comparing expression levels of DPD in the amplified mRNA from the FPE tumor sample with the mRNA from an internal control gene. Gonzalez does not teach or suggest this. Willhauck does not teach or suggest these missing elements and does not make up for the shortcomings of Gonzalez. Thus, applicants respectfully assert that the combination of Gonzalez and Willhauck do not teach nor suggest the claimed invention and therefore do not render the claims obvious. Accordingly, applicants respectfully request withdrawal of this ground of rejection.

Applic. No. 09/842,111 Amdt. dated Feb. 17, 2004

Reply to Office Action of Nov. 19, 2003

## **CONCLUSION**

It is believed that the present claims are in conditions for allowance and earnestly request allowance. Extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 11-0600. The Examiner is invited to contact the undersigned attorney if necessary to expedite allowance.

Respectfully submitted,

KENYON & KENYON

Teresa A. Lavenue Reg. No. 47,737

Date: Feb 17,2004

1500 K Street, N.W. Washington, D.C. 20005

Telephone: (202) 220-4200 Facsimile: (202) 220-4201